



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,793	02/27/2006	Toshiyuki Kanai	040894-7413	6625
9629 7590 12/12/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER LOPEZ, MICHELLE	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/569,793

**Applicant(s)**

KANAI ET AL.

**Examiner**

Michelle Lopez

**Art Unit**

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/16/07, 11/27/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

New claims 9-11 have been added.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/27/07 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olesen et al. 4,573,625 in view of Sese et al 6,923,360.

Olesen discloses a stapler comprising a cartridge 90 with staple members in a straight shape 94, a striking portion formed with a striking path, a magazine 32, a staple supply mechanism formed in the magazine as shown in Figs. 9-10, a forming plate 70 that forms the staple member in a c-shape, a driver plate 80, a clincher mechanism that folds and bends a leg of the staple member as shown in Figs. 5-6, a movable anvil via 60, a staple guide via 507 that guides the connected staples to the striking portion (fig. 17 and 21; col. 11, lines 37-53), and a fixed anvil via 508, 509 formed at front end portion of the staple guide (claim 1); the driver plate

80 and the forming plate 70 are operated on a same plane (claim 2); wherein the forming plate is formed by a plate member with legs 72 having a thickness substantially as claimed and wherein the driver plate is formed by a plate member having a thickness at 180 substantially the same as a width dimension of a section of the staple member (claim 3); and wherein the striking portion is formed at a front end of 102 of the cartridge 90 (claim 4); wherein the fixed anvil 508 protrudes into a plane in which the forming plate moves up and down as shown in fig. 21 (claim 9); a recess portion 77 formed on the forming plate 70, wherein the driver 86 is contained in said recess portion as shown in figs. 10-11 (claim 10); and wherein a width of the movable anvil 60 is smaller than a width of the fixed anvil as shown in fig. 20 (claim 11).

With respect to claims 1 and 7-8, it has been held that the recitation that an element is “capable” of performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Therefore, little consideration has been given to the limitation of “wherein the forming plate is capable of forming the staple member ... and the staple member which is successive to the staple member above the movable anvil simultaneously” in claim 1 and to “the forming plate is capable of simultaneously forming the staple member which is arranged above the movable anvil ... and a staple member which is arranged on the fixed anvil”. Furthermore, the functional language is not supported by sufficient structure to perform the forming of two staples simultaneously.

Alternatively, Sesek teaches the concept of stapler having a forming plate and anvil member which form more than one staple at a time as 42 (see col. 12, lines 6-24) for the purpose of minimizing a force required to drive the staples into a stack of papers. It would have been

obvious to one having ordinary skill in the art to have modified Olesen's forming plate to be capable of forming two staple simultaneously as taught by Sesek in order to provided a multiple-preformed staple which minimize the force required to drive the staples into a stack of papers.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant arguments asserting that the finality of the Office Action dated August 8, 2007 is premature because it introduces a new ground of rejection not necessitated by applicant's amendment, Examiner disagrees and asserts that the new ground of rejection was necessitated by applicant's amendment to claim 7 and new added claim 8 filed on 4/6/07.

Also, in response to applicant's argument that Olesen does not disclose or suggest the ability to form two staple at once, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

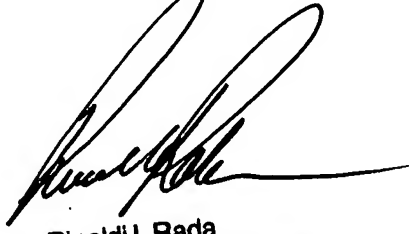
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/569,793  
Art Unit: 3721

Page 5

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ML/  
Patent Examiner



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700